

By



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,649	04/11/2001	Debbie Indira Lewis	RCA 88650	7334
7590	06/15/2005		EXAMINER	
Joseph S Tripoli Thomson Multimedia Licensing Inc P O Box 5312 Princeton, NJ 08540			VENT, JAMIE J	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/743,649	<b>Applicant(s)</b> LEWIS ET AL.	
	<b>Examiner</b> Jamie Vent	<b>Art Unit</b> 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed March 8, 2005 have been fully considered but they are not persuasive.

The applicant argues on page 7 that Custers in view of Best fails to teach, disclose or suggest the following limitation, "providing to a user during play mode of operation an opportunity to select a bookmark, representing a corresponding location within the stored information, from among a plurality of bookmarks responsive to user input, as disclosed in independent claims 1 and 11. It is noted in Figure 4 the process of determining selecting and programming the various selections of the recording. Furthermore, it is stated in Column 6 Lines 20-67 describes the starting or playing of the disc and the ability the user has of marking various selections of the streams and comparing ID codes as the disc is being reproduced and stored. Furthermore, it is additionally stated in Column 3 Lines 7-15 that the disc is played back for the user to mark segments throughout the disc and thereby additionally meeting the limitation.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Custers et al discloses a method and apparatus for controlling a system which has stored information by the use of bookmarks which is further taught by Best to use advance scheduling of bookmarks to insure that there is no discontinuity or pause in video or audio and thereby making a more precise book marking system. Although all of applicants points are understood the examiner can not agree and therefore rejection is maintained.

*Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2,3, 4, 5, 6, 7, 8, 9, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Custers (US 5,063,547) in view of Best (4,659,026).

**[claims 1 & 11]**

In regard to Claims 1 and 11, Custers et al discloses a method and apparatus of controlling a system for processing stored information on a storage medium, comprising the steps of:

- (a) Playing back stored information during operation mode (Figure 1 element 3 stores information during playback mode);
- (b) Providing to a user, during play mode of operation, an opportunity to select a bookmark, representing a corresponding location within the stored information, from among a plurality of bookmarks responsive to user input (Column 6 Lines 20-29 describes the selection of bookmark/flags to be used);
- (C) Changing to playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation, characterized in that step includes:
  - o Determining the number and maximum number of bookmarks, which may be associated with the storage medium (Figure 3 shows blocks of memory where a code is assigned to each block thereby the code becomes a bookmark to the data. Only a certain number of blocks can be held depending on the storage medium

size. Thereby it can be said the number of bookmarks can be determined due to the number of blocks of data are present as well as the maximum number of bookmarks by comparing the number of blocks that are able to fit in the storage medium as described in Column 4 Lines 31+);

- Generating an on-screen menu displaying the maximum number of the plurality of bookmarks available and the actually available ones of the plurality of bookmarks associated with the storage medium (Column 4 Lines 40+ describes showing the sequence number/bookmarks to the user. Figure 1 element 13); however, fails to clearly disclose

- a menu allowing the user to perform one of the following: setting a new bookmark, selecting a bookmark and clearing the selected bookmark, selecting a bookmark and play back the stored information from the location corresponding to the selected bookmark; and undo a previously performed operation while continuing to watch the program information playback in a background portion of the video display.

Best discloses a video entertainment system wherein prompted commands/bookmarks prompts the user to choose the outcome of the current program while in playback mode as described in Column 9 Lines 15-23. Furthermore, during playback mode a user will be presented a situation wherein the user will select the outcome of the character via use of bookmarks as seen in Figure 10 and further disclosed in Column 6 Lines 10-20. The bookmarks are presented via text or voice which allows for a new bookmark to be set and clears the current bookmark or undo a previous performed operation by selection process, as seen in Figure 9 steps 402 through 410. Furthermore, by using the technique of advance scheduling of bookmarks insures that there is no discontinuity or pause in either video or audio and that both remain in sync through the cue table rescheduling as described in Column 9 Lines 60-64. Thereby, allowing the

Art Unit: 2616

user to select command cues/bookmarks of the program allows the user to set new, clear, or undo previous bookmarks of the currently played program.

Therefore, it would have been obvious to one of ordinary skill in the art to have an apparatus for automatically reproducing a user defined selection of bookmarks, as disclosed by Custers et al, and incorporate a menu which allows the user to select new, undo or delete bookmarks as desired without interrupting current playing of the video system, as disclosed by Best, which allow the user to have full control over the video system and the desired playing features without disrupting the program.

**[claim 2]**

In regard to Claim 2, Custers et al discloses a method comprising the steps of:

- Grouping the plurality of bookmarks into sets each having a predetermined number of bookmarks (Figure 2 shows the index table comprising serial data in the form of groups of data used to group bookmarks together);
- Storing each group of bookmarks (Column 4 Lines 9-11);
- Providing to the user an opportunity to retrieve a desired set of bookmarks (Column 4 Lines 45-50).

**[claim 3]**

In regard to Claim 3, Custers et al discloses a system that changes the playback of stored information corresponding to location of data of a bookmark (Figure 1 element 3 processes the playback information while element 6 changes the stored information corresponding to the location of the selected bookmark); however, lacks to provide a user an opportunity to select a first and second bookmark from among the plurality of bookmarks. Best discloses a system wherein the user has various bookmarks to choose and select between within the system as described in Column 9 Lines 15-27 the various types of bookmarks and seen in Figure 10 the choice of run or fight.

Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to use Custers et al system of storage of bookmarks and incorporate a system that gives the user a first or second choice bookmark to select between, as disclosed by Best, which allows for the user to have more control and selection of the video program.

**[claims 4 and 10]**

In regard to Claims 4 and 10, Custers et al discloses a method wherein the step of selectively continually repeating the playback of the stored information from the location corresponding to the first selected bookmark to the location corresponding to the location of the another bookmark, in response to user control (Column 3 Lines 7-20 describe the storing of selections as well as changing the selection when user selects another bookmark to be used).

**[claims 5 & 7]**

In regard to Claim 5, Custers et al discloses a method wherein the storage medium is a CD disk, and wherein the step of determining the bookmarks actually present for the particular CD disk comprises evaluating data related to the CD disk in non-volatile memory in the disk player (Column 2 Lines 12+). Examiner takes official notice that it is obvious to one skilled in the art at the time of the invention to incorporate a DVD system, over Custers et al system comprising a CD player, in order to allow the user easier accessibility as well as a larger storage medium.

**[claim 6]**

In regard to Claim 6, Custers et al discloses a method of determining whether a bookmark is selected; however, lacks a mode of operation enabling user access to bookmarks during play mode of operation is enabled. Best discloses a system as seen in Figure 2 wherein it is detected if bookmarks are to be enable by the comparator 69 to enable access to the bookmarks. Therefore, by incorporating modes that enable or disable access to the user allows for the system to process information correctly when in recording or playback modes.

Therefore, it would be obvious to one skilled in the art at the time of the invention to use Custers et al system of storage of bookmarks and incorporate a system of enabling and disabling modes to the users in order to allow for proper execution of the bookmark depending on the present mode of operation, as disclosed by Best.

**[claims 8 & 9]**

In regard to Claims 8 and 9, Custers et al discloses a method of setting a new bookmark in response to a user command (Column 3 Lines 7+); however, lacks comprises storing data associated with a pause and resume function, including the nearest NAV\_PACK address, in conformance with the DVD specification.

Examiner takes official notice that a pause and resume function would use NAV\_PACK according to the DVD specification and it would be obvious to one skilled in the art at the time of the invention that a flag would be used for pointing to an address as seen in Claims 8 and 9 as the NAV\_PACK.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***




Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie Vent whose telephone number is 571-272-7384. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jamie Vent  
06/02/05

  
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PRIMARY EXAMINER